

In The United States Court of Appeals
For the Ninth Circuit

SAMUEL H. PALMER and C. A. WHITE, Partners Doing
Business as WESTERN FENCE & WIRE WORKS,
Appellants,

— vs. —

KARL H. KAYE, MATILDA KAYE and PACIFIC WIRE
WORKS Co., a Corporation,
Appellees.

UPON APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE WESTERN DISTRICT OF WASHINGTON
NORTHERN DIVISION

REPLY BRIEF OF APPELLANTS

F. A. LESOURD,
1510 Hoge Building, Seattle 4, Wash.

PAUL BLIVEN,
4260 W. Marginal Way, Seattle 6, Wash.
Attorneys for Appellants.

In The United States Court of Appeals
For the Ninth Circuit

SAMUEL H. PALMER and C. A. WHITE, Partners Doing
Business as WESTERN FENCE & WIRE WORKS,
Appellants,

— vs. —

KARL H. KAYE, MATILDA KAYE and PACIFIC WIRE
WORKS Co., a Corporation,
Appellees.

UPON APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE WESTERN DISTRICT OF WASHINGTON
NORTHERN DIVISION

REPLY BRIEF OF APPELLANTS

F. A. LESOURD,
1510 Hoge Building, Seattle 4, Wash.

PAUL BLIVEN,
4260 W. Marginal Way, Seattle 6, Wash.
Attorneys for Appellants.

INDEX

	<i>Page</i>
1. Appellees, in effect, admit they are making Palmer type screens	1
2. Appellees' production of Palmer type screens is intentional and not "unavoidable" or "natural"	3
3. Appellees continue to confuse issue with ambiguous language	5
4. Appellees do not show that anyone prior to Palmer conceived the desirability of or built a screen with the Palmer formation	10
5. Appellees' argument on "utility" is really argument on comparative desirability	11
6. Any of appellees' screens containing the arches intersecting in shallow crimps infringe Palmer patent	12

TABLE OF CASES

<i>Konet v. Haskins</i> (U.S.C.C.P.A.) 179 F.(2d) 1003	11
<i>Miessner v. Hoschke</i> (C.A.D.C.) 131 F.(2d) 865....	11

In The United States Court of Appeals

For the Ninth Circuit

SAMUEL H. PALMER and C. A. WHITE,
Partners Doing Business as WESTERN
FENCE & WIRE WORKS, *Appellants*,

vs.

KARL H. KAYE, MATILDA KAYE and
PACIFIC WIRE WORKS Co., a Corpora-
tion, *Appellees*.

No. 12495

UPON APPEAL FROM THE UNITED STATES DISTRICT
COURT FOR THE WESTERN DISTRICT OF WASHINGTON
NORTHERN DIVISION

REPLY BRIEF OF APPELLANTS

1.

Appellees, in effect, admit they are making Palmer type screens.

That appellees are manufacturing industrial wire screens in the form shown in the Palmer patent is implicitly admitted in appellee's brief. They state (Br. 3) that their crimps are not like the Potter screens, that they are shallower than the Potter screen. This is characteristic of the Palmer screen. Also appellees state that (Br. 7) there is an unavoidable natural curve between the crimps; that (Br. 8) in their screens there is a distortion upward in the "connecting link;" that (Br. 9) arches naturally form in their screens and are more apparent as the meshes grow smaller; and that (Br. 11, 38) this bow is unavoidable. They admit (Br. 9) that on the 1½" mesh an inspection shows a continuous curve. Thus it is in ef-

fect conceded by appellees that appellees' screens have an arch as shown by Palmer rather than having straight wires as shown by Potter.

From these statements it is apparent that appellees are not making a Potter screen and do not intend to make a Potter screen. If they were attempting to make a Potter screen they would make a sharp crimp (R. 328, line 84) consisting of deep cups "formed by crimping the bars for their whole diameter out of line at the places of crossings of the straight portions of the intersecting bars" as shown by the Potter patent (R. 328, lines 106-110). A crimp the depth of the whole diameter of the bar permits the straight wires shown by Potter.

Appellees, however, desire to take advantage of the arch and shallow crimp formation shown by Palmer. They sold Palmer's screens for years and built up a substantial business in them (R. 81-82, 237-238). When in 1944 they discontinued buying from Palmer and started manufacturing themselves, they did not make for their customers a new screen different from that which they had previously been supplying. They went right on selling to their customers with no change in description of their screens (R. 237-238). By their own admissions here, they did not manufacture a Potter screen with its straight wire and deep sharp crimps. They made and sold and still make and sell to these customers screens like plaintiffs' Ex. 2 which their customers could not distinguish from Palmer's; screens in which the crimps were shallow, consisting merely of the intersection of adjacent arches.

Appellees' production of Palmer type screens is intentional and not "unavoidable" or "natural."

Indeed, appellees' position now is that this arch and shallow crimp formation is something "natural" which they cannot avoid producing. Throughout this case the word "natural" has been used by appellees at every turn. They introduced evidence to support their claim that the wire as it came from the coil had a curve which they called "natural," completely ignoring the testimony and their own admission that this curve was removed before the manufacturing process commenced (R. 141, 160, 176). They have claimed in testimony and argument that the bending or "crimping" of the wire "naturally" produced an arch in it, ignoring the testimony of their own experts that the manufacturing process will produce whatever shape in the wire that is desired and that an arch will or will not be produced depending on how the dies are adjusted.

These previous contentions of "naturalness" are apparently now abandoned in favor of a new one. Appellees' brief here contends that the arch in their screens (or "distortion upward" as they call it) is "not a result of the manufacturing process but a natural result of the weaving process" (Br. 8). We find this word "natural" in at least six places in appellees' brief (pages 7, 8, 9, 25).

Along with this contention that the Palmer arch is "natural" is the further argument that it is "unavoidable" (Appellees' br. 7, 38).

The fact is that there is nothing whatever "natural"

or "unavoidable" in the production by appellees of screens made in the form shown by the Palmer patent. The form of their screens as finally produced is the result of intentional and careful planning.

David J. Evans, Jr., appellees' witness and head of appellees' heavy gravel screen department, testified that appellees' screens were made by arranging the die for what he thought would be the proper adjustment and pressing out several sample wires which were then woven together to determine whether the screen *as woven* was what they desired. If not, then the adjustments on the die are changed and further samples prepared until the adjustments are such as to produce a finished screen in the form desired (R. 226-229).

From this it is apparent that the final form of appellees' screens is not something produced "unavoidably" or "naturally." Contrary to the statement on page 8 of appellees' brief, the weaving process is a part of the manufacturing process and the final form of the screen is a form which is planned in advance and intentionally produced and the dies are adjusted until they will produce that desired form.

Evans, himself, directly refuted appellees' contention that the arched form of the wire in appellees' screens is something "unavoidable" or "natural" when he testified that he could make a screen with perfectly flat wires as shown in the Potter patent by making the crimp deep enough and sharp enough (R. 229). This is in accord with the testimony of appellees' other witnesses who testified that the wire in the screen can be given any desired shape. It can be made

straight like Potter's wire or arched like Palmer's simply by adjustments to the die. See Lippincott (R. 140, 146) and Guess (R. 160).

When appellees state (Br. 11) that the arch cannot be avoided in their method of manufacture and near the conclusion of their brief (p. 38) ask "can it be contended that the unavoidable bow can be patented," it is obvious, then, that their argument ignores the facts of the case even as established by their own witnesses. The Palmer screen formation is not something unavoidable or natural. Gravel screens were produced for years prior to the Palmer disclosure and there is no evidence of a single screen containing the Palmer formation. Screens can be and are produced in the Potter form with a perfectly straight wire even in very small meshes. See for example the Ludlow-Saylor screen (Pl.'s Ex. 9) and the Abbey-Scherer screen (Def.'s Ex. A-32). It is clear, then, that appellees are making Palmer form screens because they desire to do so and not because it is unavoidable or natural.

3.

Appellees continue to confuse issue with ambiguous language.

Appellees' brief in this court, as did their argument below, avoids detailed reference to the record and applies general terms such as "flat top screens" and "crimp" in a manner which ignores the specific attributes of and differences between the screens here involved. By this language appellees seek to avoid the effect of the precise limitations of the Palmer patent and claims. See for example the last paragraph

of page 5 of appellees' brief, where by use of these terms they imply that the claims of the Palmer patent are the same as Potter and Galloway. On pp. 5 and 6 they speak of an "accepted" definition of "flat top" type screen. There was no such accepted definition. Appellees chose to apply this term to a number of different patented screens. There was no agreement that this term was so applicable and the use of this term certainly does not facilitate a careful and factual disposition of the case. On page 10 appellees state that it was "finally agreed" in the lower court to apply the term "connecting link" to that part of the wire between crimps. There was no such agreement. This was a term coined by the Court below, and it merely led to confusion for the reason that appellees attempted to apply the meaning of the word "crimp" as used in the Potter patent to the Palmer patent where the word "crimp" meant something entirely different. Appellees spoke of the crimp as extending from the top of one arch to the top of the next. Consequently the Court below, we believe, never was clear as to where the "connecting link" began or ended.

With regard to the word "crimp," appellees still misuse it in their brief in this Court, in the same manner pointed out in our opening brief (Appellants' br. pp. 36-38). Moreover they confuse the word "crimp" used in the general sense of meaning any bend in a wire with the word "crimp" as used in describing a particular formation of wire in the Palmer patent. For example, on page 24 of their brief they state "admittedly, neither the arch nor the crimp are new." If they mean by this that before Palmer's inven-

tion it was known that a wire could be bent into either short or long curved portions, then this statement is correct. If they mean that the formation shown by Palmer had been previously used in an industrial wire screen, then the statement is incorrect. Again on page 28 of their brief appellees say that the Potter screen contains "the crimp" and the Galloway patent contains "the crimp and the arch." The use of the word "the" gives the impression that appellees are stating that the Potter and Galloway screens show the same crimp and arch shown by Palmer, which is not correct. Potter and Galloway show bends in the wire to which the words "crimp" or "arch" might be applied but they do not show the wire formation disclosed in the Palmer patent.

Using these words in this ambiguous sense, appellees conclude that the arches were no discovery nor was the combination of the arch and crimp a discovery. Certainly Palmer did not claim to have discovered that wire could be formed with either short or long bends, call them arches or crimps, or whatever you like. His claim is that he was the first to discover that the particular formation shown by him was desirable in an industrial wire screen and he was the first to make a screen with this form.

Appellees speak of the Potter screen as having a "comparatively flat connecting link" (Br. 2). Potter, however, speaks of the wire between crimps as straight (R. 329, line 3 and Claim 1). It is obvious that appellees are attempting to modify the Potter patent so as to make it appear that it shows some arch.

Appellees state that the Potter screen if properly manufactured will not shift (Br. 3). In support of this they cite Lippincott, Guess and Kaye. The Roebling screen concerning which Lippincott testified achieves firmness however by using the nick as a modification of Potter (R. 141, 211, 236). The testimony of Guess does not support appellees' statement. The testimony of Kaye was concerning appellees' screens which appellants contend secure their firmness by using the Palmer formation rather than Potter. As we pointed out in our opening brief (page 29), the Potter screen did not enjoy widespread use until modified.

Appellees refer to Palmer's testimony that the radius of his crimp was $\frac{2}{3}$ of the diameter of the wire (Br. 39), and say that he was understood to be referring to the depth of the crimp. He plainly referred to the radius of his crimp and appellees' misunderstanding of this and their continued talk of the depth of the crimp, which they construed to be from the top of the arches to the bottom of the crimps, caused much of the confusion at the trial.

In discussing this subject of depth of crimp (Br. 39) appellees again use the word "crimp" ambiguously. As defined in the Palmer patent the crimp is only that part of the wire which is concave toward the smooth side of the screen. This "crimp" is very short, extending only across a part of the bottom of the intersecting wire and is of almost negligible depth. Consequently when appellees speak of a crimp with a depth of 84 to 92% of the wire, they are using that term in a sense entirely different from that in

which it is used in the Palmer patent. Appellees are, in fact, using the term here, as they did below, in an attempt to make it appear that most, if not all, of the arched portion of the wire is merely part of the crimp.

This discussion on page 39 of appellees' brief has an interesting aspect, however, even though based on an erroneous interpretation of Palmer's testimony and on an ambiguous use of the term "crimp." Appellees state that if the depth of the crimp is $\frac{2}{3}$ of the diameter of the wire, it is obvious that an arch will be necessary. They then say that their crimp is of a depth of 84 to 92% of the diameter of the wire. It is, we point out, just as obvious that an arch will be necessary in the latter case as in the former. Potter secured his straight wire by "crimping the bars for their whole diameter out of line" (R. 328, lines 106-110).

4.

Appellees do not show that anyone prior to Palmer conceived the desirability of or built a screen with the Palmer formation.

Appellees' brief cites nothing in the prior art bearing on the fact that Palmer was the first to discover the desirability of the formation shown by him and to produce such a screen, other than the evidence discussed in our opening brief. Appellees make much of the window screen at the Olympic Hotel and Frank J. Seidelhuber's testimony concerning it. But as Seidelhuber admitted, this screen was only the old basket weave, over and under, the same on both sides (R. 226). Seidelhuber's testimony that he made screens

like that 30 or 40 years ago, if it has any credence, can refer only to this basket weave. We believe further that a perusal of all of Seidelhuber's testimony will show that his thinking was so disjointed and unresponsive and his testimony in such generalities as to give it little, if any, weight. Furthermore, the Olympic Hotel window screen was never used as an industrial wire screen and does not indicate any discovery that any particular formation of wire would be suitable in an industrial screen (R. 175).

Likewise, the Tyler screens (Def.'s Ex. A-36) were the old basket weave, the same on both sides, and did not show a screen with the Palmer formation (R. 264). Tyler made some screens with oblong openings which gave them a different look but they were still the old double crimp. Moreover, these Tyler screens have no bearing on the prior art in this case as they were admitted solely for the purpose of construing the claims of the patent (R. 249-252).

We repeat again, therefore, that there is no showing in this case that anyone prior to Palmer ever conceived that a screen of Palmer's formation would be desirable for industrial purposes and there is no showing that such a screen was ever previously built.

Lippincott and Dobson testified that they knew that a screen could be made with an arch similar to Palmer's but neither built such a screen and Lippincott testified that he thought it not desirable. These men were unable to see what Palmer saw, that an industrial wire screen with intersecting arches has definite advantages.

To constitute anticipation there must be a showing

that a similar screen previously was reduced to practice and a witness's conclusions alone, based upon memory and unsupported by other evidence, are not sufficient. *Konet v. Haskins* (U.S.C.C.P.A.) 179 F. (2d) 1003; *Miessner v. Hoschke* (C.A.D.C.) 131 F. (2d) 865. Mere general conclusions by appellees' witnesses here that the Palmer screen was not new certainly would not be sufficient to show anticipation.

5.

Appellees' argument on "utility" is really argument on comparative desirability.

Appellees argue that the Palmer screen lacks utility (Br. 28). This argument is based on the requirement of the statute that a device to be patented must be useful. Appellees, however, misconstrue the requirement of utility which, as we pointed out in our opening brief (pp. 51-52), is only that the device will operate as set forth in the patent. There is no requirement that it supplant everything or anything else in the art.

The argument on utility made by appellees is really one as to comparative desirability between the Palmer and Potter screens, or that the Palmer screen offers no advantages. If, as appellees argue, the Potter screen is the more desirable, and the Palmer screen has no advantages, then why do not appellees make the Potter screen? They admit in their brief, as we summarized in the first paragraph of this brief, that they are not making the Potter screen. Yet the head of their manufacturing department, Evans, states that they could make the screens with the deep crimp and straight wires of the Potter patent if they so

desired. Obviously, they have found it more desirable to use the arch formation with the shallow crimp shown by Palmer. Roeblings, likewise, now find it desirable to produce screens with the Palmer formation as shown by Def.'s Ex. A-5. Lippincott recognized that the Palmer formation was less severe on the wire (R. 144-145) and appellees admit that it furnishes additional lateral support to the transverse wires (Appellees' br. p. 5). We believe that there can be no doubt in this case of desirability of the Palmer screen and that it produces beneficial results in use.

6.

Any of appellees' screens containing the arches intersecting in shallow crimps infringe Palmer patent.

Appellees state (page 7) that appellants admit that appellees' screens of the wider meshes do not infringe. This is not true. Also, appellees state (page 37) that appellants' counsel, on motion for new trial, disclaimed in open court all claims of infringement except as to the 1½" mesh. This likewise is not true.

The position of appellants throughout this case has been that appellees are infringing as shown by Pl.'s Ex. 2 and by the testimony of Palmer and Essley that they have seen a large number of appellees' screens with the same arch formation contained in Ex. 2 in users' places of business. Appellants were able to secure only the one exhibit of appellees' screen for introduction into evidence because the other screens were being used by customers and could not readily be removed to Court. Having secured only one of appellees' screens for use as an exhibit, appellants in-

troduced one of their own screens of the same size for comparison. The reason why appellants did not introduce the full line of their screens was that they had not secured as exhibits any comparable screens of appellees.

Appellees introduced some screens of other sizes together with a number of wires, many only partially formed. These wires are not representative of the shape of the wire in the finished screen because, as appellees admit, the wires are deformed in the weaving process. It may be, of course, that appellees are making some screens that do not infringe appellants' patent. Appellants' position is that any screen sold by appellees which contains the arches intersecting in shallow crimps as shown in Pl.'s Ex. 2, is an infringement. It is obvious from Ex. 2, and from the testimony, that appellees are selling some screens of this type and, therefore, are infringing. We insist that any screen, no matter what the size, that shows the same formation of wire as found in Pl.'s Ex. 2 is an infringement. The task of determining how many screens of this type have been produced by appellees is that of the District Court and Master in determining damages. At this stage of the case the only issue before the Court is whether there has been infringement of a valid patent. Pl.'s Ex. 2 and the testimony establish that there has been infringement.

Respectfully submitted,

F. A. LESOURD,

PAUL BLIVEN,

Attorneys for Appellants.